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**Datasheet for the decision
of 15 January 2020**

Case Number: J 0006/19 - 3.1.01

Application Number: 15848194.5

Publication Number: 3204334

IPC: C02F1/46, C02F1/76, C02F1/50

Language of the proceedings: EN

Title of invention:
SYSTEM AND METHOD FOR OXIDATION OF AMMONIA

Applicant:
Xogen Technologies Inc.

Headword:

Relevant legal provisions:
EPC Art. 67(4)
EPC R. 139

Keyword:
Withdrawal of an application - Correction of error after
publication (No) - Telephone call - Protection of legitimate
expectations (No)

Decisions cited:

J 0025/03, J 0004/97, J 0014/04, J 0012/03, J 0002/15,
G 0002/97, T 0160/92, T 0993/06, R 0004/09, J 0010/87

Catchword:



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

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Case Number: J 0006/19 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 15 January 2020

Appellant: Xogen Technologies Inc.
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Representative: V.O.
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Decision under appeal: **Decision of the Receiving Section of the
European Patent office posted on 12 March 2019
rejecting the request for correction of the
letter withdrawing the European patent
application No. 15 848 194.5.**

Composition of the Board:

Chairman W. Sekretaruk
Members: A. Jimenez
C. Josefsson

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Receiving Section posted on 12 March 2019 rejecting the request under Rule 139 EPC dated 21 December 2018 to correct the letter withdrawing European patent application No. 15 848 194.5.
- II. By letter dated 19 December 2018, received at the EPO on the same date, the applicant (now appellant) requested the withdrawal of European patent application No. 15 848 194.5, filed on 9 October 2015 as an international application under the Patent Cooperation Treaty (application No. PCT/CA2015/051030). It also requested the refund of the corresponding examination fee.
- III. On 20 December 2018, the formalities officer issued Form 2058, "Closure of the procedure in respect of application n° 15848194.5", ordering the refund of 100% of the examination fee. The withdrawal was published in the European Patent Register early in the morning of 21 December 2018.
- IV. The request to correct the letter withdrawing the application was received at the EPO at 10.57 hrs on the same day as the publication of the withdrawal.
- V. In the decision under appeal, the Receiving Section held that the letter dated 19 December 2018 constituted a valid, unambiguous withdrawal, which therefore had immediate effect. The letter dated 21 December 2018 requesting the retraction of the withdrawal was received only after the publication of the withdrawal in the European Patent Register on 21 December 2018 and was not open to public file inspection until

22 December 2018. Thus, the Receiving Section rejected the request to retract the letter withdrawing the application and ruled that European patent application No. 15 848 194.5 was deemed withdrawn as of 19 December 2018.

VI. On 13 May 2019 the appellant filed notice of appeal requesting that the appealed decision be set aside, that the request for retraction of the erroneous withdrawal be granted and that the examination proceedings be continued. On the same day, it paid the appeal fee and filed the statement setting out the grounds of appeal.

VII. The appellant's submissions, where relevant to the present case, may be summarised as follows:

(a) The time requirement of Rule 139 EPC has been met. The interests of third parties have been safeguarded because the request for retraction was received by the EPO on the day the withdrawal was published. It does not matter when such a request for retraction becomes accessible for inspection by a third party, since the retraction may be granted retroactively as long as it has been requested in due time.

(b) The appellant is entitled to the protection of its legitimate expectation that its request for retraction would be filed in due time because it relied on the advice given orally on 20 December 2019 by the formalities officer that this request could be filed "...within two days", i.e. until 21 December 2018.

(c) The withdrawal is due to a "twofold excusable oversight", which permits the applicant to seek retraction in line with Rule 139 EPC.

VIII. In a communication dated 4 November 2019, the Board set out its provisional opinion that the time requirement of Rule 139 EPC had not been met and that the conditions for the application of the principle of the protection of legitimate expectations had not been fulfilled.

IX. The appellant did not file any further comment and did not attend the oral proceedings held on 15 January 2020.

Reasons for the Decision

1. Admissibility of the appeal

The appeal is admissible. It complies with the requirements of Articles 106 to 108 and Rule 99 EPC.

2. Correction of the withdrawal under Rule 139 EPC

2.1 The appellant did not contest that its request for the withdrawal of the application received by the EPO on 19 December 2018 was unqualified, unambiguous, unconditional and duly signed by the authorised representative. It was thus a valid withdrawal, which is binding on the applicant. It had immediate effect (see J 25/03, J 4/97; see also Legal Advice by the EPO No. 8/80, OJ EPO 1981, 6).

2.2 In the event of a withdrawal by mistake, Rule 139 EPC may be applicable.

When a published European patent application is withdrawn, the provisional protection under Article 67(1) and (2) EPC retroactively ceases to apply. The European patent application is deemed never to have had any protective effect (Article 67(4) EPC).

As retracting a withdrawal has a serious impact on the application, which for example becomes pending again, such a correction may only be allowed if legal certainty has been guaranteed for the party and for the public.

2.3 The case law has developed strictly defined conditions, based on this requirement of balancing the interests of the applicant and of third parties.

- A request for retraction of a letter of withdrawal of a patent application is no longer possible if the public has been officially notified of the withdrawal (J 10/87, point 13 of the Reasons) and if, in the circumstances of the case, even after file inspection, there would not have been any reason for a third party to suspect, at the time of the official public notification, that the withdrawal could be erroneous and later retracted (J 25/03, points 10 and 11 of the Reasons).
- The erroneous withdrawal is due to an excusable oversight (J 10/87, point 13 of the Reasons).
- The requested correction does not result in a substantial delay of the proceedings (J 10/87, point 14 of the Reasons).
- The interests of third parties who may possibly have taken notice of the withdrawal by inspection

of the file are adequately protected (J 10/87, point 13 of the Reasons).

- 2.4 Regarding the first condition, namely that the retraction is applied for before notification of the withdrawal to the public, the applicant does not contest that an entry in the European Patent Register recording the withdrawal of a patent application fulfils the same function as a publication in the European Patent Bulletin, in that it amounts to notification to the public (see J 25/03, point 9 of the Reasons; see also J 14/04, J 12/03, J 2/15).

In this case, the withdrawal appeared in the European Patent Register early in the morning of Friday, 21 December 2018, after the publication run.

The public had thus already been officially notified of the withdrawal of the application when the request for retraction of the withdrawal was received by the EPO on 21 December 2018 at 10.57 hrs.

- 2.5 Furthermore, at the time of the official notification, the public had no reason to suspect that the withdrawal could be erroneous and later retracted.

As already noted, the request for withdrawal was unqualified, unambiguous and unconditional. And the request for retraction of the withdrawal, filed on 21 December 2018, would not have been available for file inspection until at least the following day, 22 December 2018.

- 2.6 It is therefore of no relevance to the present decision that the request for retraction was received on the same day the withdrawal was published. The reasoning of

J 25/03, where only four days elapsed from the mention of the withdrawal in the Register of European Patents to the addition to the file of the request for retraction of the withdrawal, can be applied to the present case:

"The official notification to the public of the withdrawal is a key step and legal certainty would suffer unacceptably if further delay, even for an allegedly "short" period of time, were permitted for retraction of the withdrawal in such circumstances as the present ones, where even after possible inspection of the complete file there would not have been any reason for a third party to suspect, at the time of the official notification to the public of the withdrawal, that the withdrawal, could be erroneous and later retracted."

(point 11 of the Reasons)

- 2.7 The Board concludes that the time requirement of Rule 139 EPC has not been met.
- 3. Protection of legitimate expectations
 - 3.1 The appellant considers that it is entitled to the protection of its legitimate expectation that its request for retraction would be filed in due time because it relied on misleading advice given orally by the formalities officer on 20 December 2018.
 - 3.2 The Board finds however that the conditions for the application of the principle of the protection of legitimate expectations have not been met.

- 3.3 The principle of the protection of legitimate expectations is a general principle that is well established in European Union law and generally recognised in the EPC contracting states and Board of Appeal case law (G 2/97, point 1 of the Reasons).
- 3.4 The Boards of Appeal have developed a substantial body of case law relying on this principle, which requires that measures taken by the EPO should not violate the reasonable expectations of the parties to such proceedings.
- 3.5 The application of the principle of the protection of legitimate expectations implies inter alia that the applicant must suffer no disadvantage as a result of having relied on erroneous information received from the EPO. If its actions were based on a misleading communication, it is to be treated as if it has satisfied the legal requirements.
- 3.6 The principle of the protection of legitimate expectations governs all procedural action taken by EPO employees vis-à-vis parties to proceedings, including telephone calls, which are not part of the formal procedure (see T 160/92, point 3.3; T 993/06, point 1.2)
- 3.7 The appellant claims that it relied on the advice given orally on 20 December 2018 by the formalities officer that its request for retraction could be filed up to 21 December 2018.

It submits an affidavit by Ms Nicole Schuster (D10), employee of the firm of European patent attorneys representing the appellant, in which she states:

"In the subsequent telephone conversation with a formalities examiner of the EPO on the same day [i.e. 20 December 2018], I received the information that the request for retraction of the withdrawal has to be filed within two days from filing the request of the withdrawal of the application.

I informed Dr. Hermann about the information obtained, i.e. that the request for retraction has to be filed with the EPO by 21 December 2018. A related request was then drafted explaining the erroneous instructions from Dr. Nauman in relation to the withdrawal. The request for retraction of the withdrawal was filed with the EPO in the morning of 21 December 2018, i.e., within the time frame indicated by the EPO."

3.8 Although no trace of this telephone call can be found anywhere in the file, this document is sufficient to prove that a telephone conversation with an EPO employee regarding the possibility of retracting the withdrawal took place on the said date. But the Board is not convinced that this affidavit written on 13 May 2019, several months after the telephone call, is sufficient to prove what exactly the EPO employee said.

3.9 This question can however be left unanswered, since in any case the authorised representative is expected to be aware of the relevant law and case law (see R 4/09, point 2.3.3). As such, they are deemed to know:

- that an unambiguous withdrawal of an application has immediate effect,
- that there is no legal provision in the EPC setting a period of time during which a retraction of the withdrawal is allowable, and

- that the withdrawal cannot be retracted after it has been published in the European Patent Register.

3.10 Even assuming that the content of the telephone conversation with the formalities officer is sufficiently proven, the professional representative thus should have been aware that any period mentioned could only be an indication of the time that usually elapses before publication of a submission in the Register.

3.11 The professional representative could also be expected to be familiar with procedural matters in general and to be acquainted with all notices and forms published by the EPO. In particular they are expected to know that a filed document is likely to become visible in the European Patent Register once it has been coded by the EPO (see FAQ - European Patent Register on the EPO website).

In this case, Form 2058, "Closure of the procedure in respect of application n° 15848194.5", was issued on 20 December 2018. The appellant could then have expected the withdrawal to be published early in the morning of the following day, after the publication run. Thus, it was the appellant's own responsibility to file the request for retraction before the withdrawal appeared in the Register.

4. Other requirements for the correction of the withdrawal

The request for correction of the withdrawal was not filed in due time. Any other requirements for such a correction or their possible fulfilment, in particular whether the erroneous withdrawal is due to an excusable oversight, need not be considered.

5. Therefore, the request for retraction of the withdrawal of the application cannot be granted and the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated